



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,103	04/16/2004	Hitoshi Saito	SON-3000	7692

23353 7590 03/05/2007  
RADER FISHMAN & GRAUER PLLC  
LION BUILDING  
1233 20TH STREET N.W., SUITE 501  
WASHINGTON, DC 20036

EXAMINER
----------

RENNER, CRAIG A

ART UNIT	PAPER NUMBER
----------	--------------

2627

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/825,103

Applicant(s)

SAITO ET AL.

Examiner

Craig A. Renner

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>26 October 2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of "Species I, Figures 1-8," upon which "claims 1-4, 6 and 7" are said to "read," in the reply filed on 17 January 2007, is acknowledged. Claim 3, however, does not read on the elected species as elected species I of FIGS. 1-8 does not include "wherein said decorative panel further comprises... engaging pieces." Non-elected species II of FIG. 9 teaches the decorative panel further comprising at least one engaging piece. The traversal is on the ground(s) that "the subject matter of all claims is sufficiently related that a thorough search of the subject matter of any one group of claims would necessarily encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP 803, which is, stated that 'if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims that are distinct or independent inventions.'" This argument, however, is not found to be persuasive because each of the various disclosed species details a mutually exclusive characteristic of a disk drive apparatus as evidenced by the representation of each various species with a different figure or set of figures. A search for one of these mutually exclusive characteristics is not coextensive with a search for the other mutually exclusive characteristics and therefore searching for all mutually exclusive characteristics could not be done without serious burden.

The requirement is still deemed proper and is therefore made FINAL. Accordingly, claims 3 and 5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to one or more non-elected inventions/species, there being no allowable generic or linking claim.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

3. The drawings are objected to because of the following informalities:

a. The drawings fail to comply with 37 CFR 1.84(p)(5) because they include one or more reference signs not mentioned in the description. Note, for instance, "22e" (shown in FIG. 9, for instance), "23e" (shown in FIG. 9, for instance) and "23f" (shown in FIG. 9, for instance).

b. In FIG. 3, the upper, right reference sign "6b" should be changed to --6d-- in order to be consistent with the remainder of the disclosure.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) and/or an amendment to the specification in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing

Art Unit: 2627

sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
5. The abstract of the disclosure is objected to because it is not "on a separate sheet." Note that the abstract of the disclosure included in the clean version of the substitute specification filed on 26 October 2005 is on two sheets, i.e., pages 13 and 14, and page 13 is not separate from the remainder of the disclosure (emphasis added). Appropriate correction is required. See MPEP § 608.01(b).
6. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Note, for instance, line 21 on page 1 of the substitute specification filed on 26 October 2005. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, 4, 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Many elements in the claims are indefinite because they lack clear and/or positive antecedent basis including "the inserted disk" (line 3 of claim 1), "said one of first engaging pieces and first engaging grooves" (line 3 of claim 4), "said one of first engaging pieces" (line 5 of claim 4) and "the first engaging grooves" (line 5 of claim 4).

b. In line 4 of claim 7, it is indefinite as to which of the "shorted-side members," set forth in line 5 of base claim 2, is being referenced by "the shorted-side member."

c. Claims 2 and 6 inherit the indefiniteness associated with independent claim 1 and stand rejected as well.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsuji et al. (US 5,207,342).

Tsuji et al. (US 5,207,342) teach a disk drive apparatus comprising a disk drive body (2) including a front face (between 23a and 23b) having an insertion opening of a disk (as shown in FIG. 1, for instance) and side faces (adjacent each 24, for instance) substantially parallel to a recording surface of the inserted disk (as shown in FIG. 1, for instance); and a decorative panel (1) covering approximately the entire surface of the side faces and being disposed so as to be detachable from the side faces (as shown in FIGS. 2A-2D, for instance) [as per claim 1]; wherein the decorative panel comprises a flat panel portion shaped as a rectangle by having a periphery thereof with longer-sides and shorter-sides (as shown in FIG. 1, for instance); shorter-side members (11 and/or 14, for instance) disposed along the shorter-sides of the flat panel portion; longer-side members (adjacent 13a and/or 13c, for instance) disposed along the longer-sides of the flat panel portion; and one of a first engaging piece and a first engaging groove (4a, for instance, i.e., a first engaging piece) provided at the shorter-side members for engagement with the disk drive body (as shown in FIG. 2D, for instance) [as per claim 2]; wherein the decorative panel further comprises a plurality of the one of first engaging pieces and first engaging grooves (4a, 4b and 11, for instance, i.e., first engaging pieces); second engaging grooves (between 14a and 13a and between 14b and 13c, for instance) for engagement with the disk drive body (as shown in FIGS. 2B-2C, for instance), the number (i.e., 2) of which is less than the number (i.e., 3) of the one of first engaging pieces and the first engaging grooves (as shown in FIG. 1, for instance), and

being disposed at the longer-side members (as shown in FIG. 1, for instance) [as per claim 4]; wherein the decorative panel has a second engaging groove (between 14a and 13a and/or between 14b and 13c, for instance) which is disposed at the longer-side members (as shown in FIG. 1, for instance) for engagement with the disk drive body (as shown in FIGS. 2B-2C, for instance); and the second engaging groove is formed so as to be smaller than a first engaging groove (part of 11, for instance, as shown in FIG. 1, for instance) [as per claim 6]; and wherein the disk drive body is disposed in the vicinity of the one of first engaging piece and first engaging groove in a state in which the decorative panel is installed on the disk drive body (as shown in FIGS. 2A-2D, for instance), and the disk drive body has a recess portion (21a) disposed so as to oppose to the shorter-side member (as shown in FIG. 1, for instance) [as per claim 7].

### ***Claim Rejections/Considerations - 35 USC § 103***

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Pertinent Prior Art***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes Coleman (US 4,220,338), Russell et al. (US 5,216,582), Anderson et al. (US 6,015,195), Ahn (US 6,480,453), Komatsu et al. (US



Art Unit: 2627

2003/0053247), Takagi et al. (US 2003/0058772), Konno (US 2004/0057152), Komatsu et al. (US 2004/0184185), Aeiba (JP 2000-057742), and Aeiba (JP 2000-057743), which each individually teaches a disk drive apparatus with a detachable decorative covering panel.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (571) 272-7580. The examiner can normally be reached on Tuesday-Friday 9:00 AM - 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Application/Control Number: 10/825,103

Page 9

Art Unit: 2627

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Craig A. Renner  
Primary Examiner  
Art Unit 2627

CAR